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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,465	01/04/2001	William J. Gray	10655.9900	3628

66170 7590 04/03/2007  
 AMERICAN EXPRESS TRAVEL RELATED SERVICES CO., INC.  
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 PHOENIX, AZ 85004-2202

EXAMINER
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HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/754,465

**Applicant(s)**

GRAY ET AL.

**Examiner**

Calvin L. Hewitt II

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,39 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### ***Status of Claims***

1. Claims 1, 3-5, 39 and 40 have been examined.

### ***Response to Amendments***

2. Applicant's claims have been amended to recite "receiving a digital certificate, read by said card reader system...", and "authenticating, by said security server, that said smart card was read by said card reader system". Applicant's Specification is silent either of the above features. Similarly, Specification continues to fail to disclose "receiving, at a security server, said digital certificate...". Regarding prompting a user to physically interface a smart card with a card reader system, this feature is old and well known.

Applicant continues to recite configuring data. In support of this limitation, Applicant cites configuration files that are used to configure initial settings for a computer program, for example. However, Applicant's digital certificate doesn't configure anything, to the contrary, Applicant is asserting that the certificate itself is configured. Hence, as Applicant has not sufficiently responded to the Examiner's rejection, the 112 second paragraph continues to apply to claims 1, 3-5, 39 and 40-43 (The fix: a smart card that comprises a digital certificate wherein the digital certificate uniquely identifies the smart card).

Applicant's claims are replete with new and indefinite subject matter, therefore, the Examiner is interpreting the claims as follows:

- (claims 1 and 40) receiving a request at a wallet server, from a user, for payment authorization, said payment authorization directed to a financial institution
- prompting a user to physically interface a smart card with a smart card reader (claims 1 and 40)
- (claims 1 and 40) receiving authorization of said request by said wallet server, from a security server
- (claims 1 and 40) associating authentication data, by said wallet server with a form
- (claims 1 and 40) providing said form to a merchant server to facilitate the use of said form to obtain authorization from said security server
- (claim 3) method of claim 1 wherein said request is a secure checkout procedure
- (claim 4) method of claim 1 wherein said wallet server is a web, database or application server
- (claim 5) claim 1 further comprising inserting smart card data onto a client or computer system

- (claim 39) an interface configured to receive an authorization request from a user
- (claim 39) a module configured to provide a form to a merchant server to facilitate the use of said form to obtain authorization from a security server

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3-5, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's claims have been amended to recite "receiving a digital certificate, read by said card reader system...", and "authenticating, by said security server, that said smart card was read by said card reader system".

Applicant's Specification is silent either of the above features. Similarly,

Specification continues to fail to disclose "receiving, at a security server, said digital certificate...".

Claims 3-5 are also rejected as they depend from claim 1.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 3-5, 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 39 and 40 recite "a digital certificate... configured", however, to one of ordinary skill a digital certificate is data and not a physical structure, hence it is not configurable.

Claims 3-5 are also rejected as they depend from claim 1.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-5, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan, U.S. Patent No. 6,327, 578.

As per claims 1, 3-5, 39 and 40, Linehan teaches a method for facilitating a transaction comprising:

- receiving a request at a wallet server, from a user, for payment authorization, said payment authorization directed to a financial institution (column/line 5/61-6/4) where said wallet server is a web, database or application server (figure 7)
- receiving authorization of said request by said wallet server, from a security server (figures 2B and 8; column 6, lines 1-35; column/line 8/53-92)
- associating authentication data, by said wallet server with a form (column 6, lines 36-43)
- providing said form to a merchant server to facilitate merchant using said form to obtain authorization from a security server (column 6, lines 36-43 and 47-62)
- receiving the request as part of a secure checkout procedure (figure 2B; column/line 5/50-6/3)

- an interface configured to receive an authorization request from a user (figure 2B)
- a module configured to provide a form to a merchant server to facilitate the use of said form to obtain authorization from a security server (column 6, lines 36-43 and 47-62)

Linehan teaches a user utilizing a smart card to make a purchase (figure 2C; column 7, lines 20-38) such as by inserting the card into a smart card reader (column 7, lines 26-30). Prompting a user to insert a smart card into a smart reader is old and well known, therefore it would have been obvious to one of ordinary skill to prompt a user to insert a smart card as a means of guiding a user through a transaction process.

Regarding a coincidence between the security server from which the wallet server receives authentication data and the security server that receives a "form" from a merchant. Linehan teaches a security server such as a bank (figure 2A, items 208 and 212), therefore, if in the Linehan model, the merchant and the user share the same bank or financial institution, this limitation is satisfied.

Regarding "forms", in order to settle a dispute a merchant can produce a copy of the token that contains data such as payment amount, order description, time stamp, a random nonce, merchant ID, and customer account reference number. Further, the token is completed, and transmitted to a merchant by the



wallet server and the merchant server, in turn, transmits the token to a security server (column 6, lines 20-37). Hence, the token of Linehan satisfies the conditions of a "form" according to Applicant's Disclosure (Specification, page 10, lines 17-28).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Clark teaches prompting a user to insert a smart card into a smart card reader
- Deo et al. teach uniquely assigning a digital certificate to a smart card and using the certificate to authenticate the card in a financial transaction
- Williams et al. teach an interface for selecting a wallet and using the wallet to make online purchases (see figures 9, 10, 16 and 17)

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

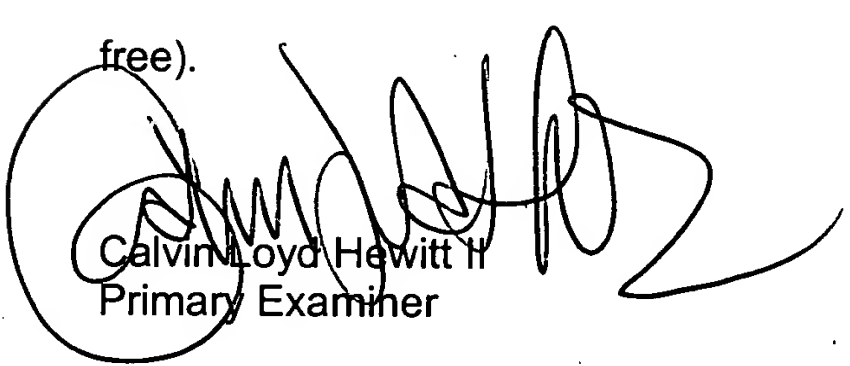
Art Unit: 3621

number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Lloyd Hewitt II  
Primary Examiner

March 31, 2007